

**Application number:** 09/923,311

**Art Unit:** 3624

**Applicant:** Khai Hee Kwan

**Examiner:** Alain L Bashore.

**Title:** A computer network method for conducting payment over a network by debiting and crediting utilities accounts

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TO: Commissioner for Patents  
Virginia 22313-1450

Sir:

The examiner in his Action letter mailed 10 Jan 2005 asserted the following at page 2 :

The reply filed on 10-24-04 and 10-26-04 are not fully responsive ( taken as a whole) to the prior office action because of the following omission(s) or matter(s) :

A separate paper listing all the claims ( a 'clean' copy of the claims) is required without underling and brackets (after each claim number). The rules now in effect no longer require the submission of a marked up copy of the claims.

Our Remark to Action letter mailed 10 Jan 2005.

We apologize for the inconvenience. Two replies were send because of transmission problem. To expedite this prosecution, we hereby submit the entirety of the previous reply including the clean copy of the claims as per above. To avoid confusion we hereby submit that this reply version supersedes the previous submissions in their entirety.

Please note that we have also taken the opportunity to better organize our rebuttal as detailed. Without conceding the validity of the examiner's arguments and to expedite

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prosecution of the application, we have also included a section entitled "Explanation to Our Amendments" to better explain the current amendments in view of the prior arts. In part, we have included this to avoid any possible informalities objection for non proper response which will only delay this prosecution. Our earlier two submissions dealt entirely with attacking the examiner's *prima facie* evidence.

The following pages comprise our response to the Action Letter mailed 28 July 2004, including Declaration, Markup copy and Clean copy. We submit this would satisfy ALL informality issues.

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Remark to Action Letter mailed July 28, 2004.

Summary.

In reply to Office Action mailed on July 28, 2004, we respectfully ask the examiner to consider our response below.

We respectfully traverse the examiner's assertion that claims 1-16 are obvious under 103(a) in view of Morrill, Jr (US 5991749 filed 9 Sept 1997) and in view of Mousseau et al ( US Application 2002/0120696 A1 filed 6 April 2001) and that claim 17 is obvious in view of the above and further Resnick (US 6,185,545 B1 filed 17 Nov 1999)

Our main rebuttal is that none of the prior arts suggest the application of utilities accounts for payment transfer. The question is why would Morrill suggest reaching/using the Internet as per our claim when its mobile service provider's link is already linked to the mobile phone device ? The examiner provided no evidence to show how Morrill would inherently show using utilities account (other than mobile phone account which in our amendment has excluded). Furthermore, our claimed invention, our payment initialization is via the Internet and NOT via a wireless network such as mobile phone network or PSTN because our utilities accounts are not mobile phones accounts and hence without the advantage of the direct link to mobile provider system. For example gas utilities account by itself could not be connected to a mobile device since they uses different elements.

Our claimed invention uses utility accounts ( now amended to exclude mobile phone accounts) as the means for payment over the net. Even if mobile phone account could inherent be found in utilities accounts (we submit that this is not and nothing has been stated by the examiner to reveal this), Morrill's invention still would not obvious for initiating a payment transaction over the internet (first network) and/or using a mobile

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device over PSTN ( second network) to confirm and verifying said transaction between two utilities accounts. The claim must be viewed as a whole. Gen. Foods Corp. v. Studiengesellschaft Kohl mbH, 972 F.2d 1272, 1274, 23 USPQ2d 1839, 1840 (Fed. Cir. 1992) ("each claim is an entity that must be considered as a whole"). Morrill's invention is for the use of a mobile device for initiating payment instructions to a mobile service provider between mobile accounts holders over a telecommunication network. The most persuasive evidence could be found at Col 6 lines 39 to 45 where Morrill describes linking computers and herein restated " The computers must be connected to a phone line or must be equipped with an RF antenna and receiver, so that they can receive information from the mobile phone service provider's CPU either by land line connection or wireless transmission. " Also see Col 7 lines 33-34. It is clear this refers to a PSTN and not to the Internet as the first point to reach a service provider's server.

Dependent Claims includes all of the limitations of the independent claim 1. Neither of these references includes any suggestion to combine its features with the features of the other reference. According, applicant respectfully submits that the claims as previously presented and currently amended are also patentable over Morrill, in view of Mousseau and Resnick.

We reiterated the definition of utilities in this application to gas, electricity, water and communication data accounts. We have reproduced our definition at page 2 of our application : "Utility is defined such as gas, water, electricity or communication data that are essential to most modern home or premises." Also at page 4 under Summary "And in both cases they are merely book entries into the accounts with the utility providers such as gas, water, communication or electricity". There is no evidence to show data communication channel accounts must necessarily reveal a mobile telephone voice account.

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Morrill teaches mobile telephony system to function as an electronic wallet etc to enable payment facilitation using telco accounts ( Col 4 ln 1-39) but NOT utilities accounts as defined above. There is no explanation as to how a mobile phone account could inherently be a gas, electricity, water or data communication accounts nor is it known in the art that there are significant characteristics or interconnectivity in the technology or process amongst them. For example, it is doubtful whether gas can travel via an electricity line. Further, mobile phone account uses air-time as a measurement (10 mins) while in electricity account, it use kWh as unit of measurement or in Data Account (Mega-Bytes downloaded). This means an article for sale or amount to be transferred could be quoted to measure say 300 MB or 400 kWh (as per Utility Units in our specification and claim 2). Morrill made no teaching that his invention could use air-time as a proxy for monetary unit nor could 10 mins show 10 kWh to one ordinary skilled in the art. An inherent disclosure, to be invalidating as an "anticipation," is a disclosure that is necessarily contained in the prior art, and would be so recognized by a person of ordinary skill in that art. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). "Inherency" charges the inventor with knowledge that would be known to the art, although not described. Inherency is not a matter of hindsight based on the applicant's disclosure: the missing claimed elements must necessarily be present in the prior art but may be inherently disclosed by prior art if " the prior art necessarily functions in accordance with the limitations " ( King, 801 F.2d at 1326; see also Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369 (Fed. Cir. 1991)) and be "practice without undue experimentation" (Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000)) by one skilled in the art.

We respectfully submit that the prior art would not necessarily work with an utility account given the incompatibility between the needs of a mobile phone account using air time as unit measurement for cost and one applying say kWh and even if this is possible (

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not probable ), one skilled in the art would not be able to practice without undue experimentation.

Secondly, there is NO reason why Morrill would modify his mobile device to connect to the Internet to reach its service provider for initiating a payment when it already has a direct connection to its service provider by wireless means. Morrill only taught the sending of the receipt code generated from a completed purchase transaction by interfacing with a PC to another PC over the internet. ( Col 12 at line 3 to line 9 ). This is however not the same as suggesting there is motivation to connect the mobile service provider over the Internet given the payment transaction is already completed.

To show obviousness under 103(a), the examiner is required to articulate a motivation for Morrill to modify a mobile phone account to reach a gas account (for example) for payment or that a mobile phone account could inherently show a gas account as seen by one skilled in the art of payment.

The examiner did not articulate any motivation or even mentioned the difference between telco and other utilities accounts such as gas, electricity, data, water etc; which we submit could only suggest the examiner did not appreciate the differences... See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1255-57, 9 USPQ2d 1962, 1965-66 (Fed. Cir. 1989) ("To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality.").

Similarly, Mousseau's invention is not even in the field of payment but teaches pushing data from a mobile device. Therefore the question is where is the motivation found in either prior arts for them to be so combine ? In combining two prior arts or more, the motivation must be found to benefit both combined arts which in this case, a need for synchronization of wireless device for payment. There is nothing in Morrill to show a

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need for synchronizing data wherein the mobile device is for initiating/making payment. While it may be 'important' as per para 0007 of Moussaeu according to the examiner ( at page 4 of Action Letter), neither Mousseau nor Morrill point out a need to combine synchronization with an initiating/payment wireless device. It is well known that Morill's device is for initiating and executing a payment by giving wireless message instructions to a telco host where the latter in response issues a receipt upon completion of a payment instruction. So why is there a need for synchronization and even if there is a need what is being synchronized in Morrill and for what purpose ? In Morrill, it has been taught that when making a payment (face-to-face) the confirmation could be done by sending the receipt to the payee by communicating with his mobile device. (Col 3 line 15-20)

There must be a showing of some "teaching, suggestion, or reason" to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . . .") (emphasis added); *Monarch Knitting*, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question). The examiner asserted that " Moussaeu et al teaches the importance of synchronization for wireless device communication (para 0007) " which is reproduced below;

"[0007] A general problem with these known synchronization systems is that the only time that the user data items are replicated between the host system and the mobile data

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communication device is when the user commands the mobile device to download or pull the user data from the host system. Five minutes later a new message could be sent to the user, but the user would not receive that message until the next time the user fetches the user data items. Thus, a user may fail to respond to an emergency update or message because the user only periodically synchronizes the system, such as once per day. “

The question is whether Morrill has a requirement (hence motivated) for such a synchronization step and not whether it is important for wireless devices to have this step. As we said, Morrill's invention is for payment between telco accounts and the wireless devices are only tools for such purposes. The underlying fact is that there is no evidence provided by the examiner to show that Morrill needed to combine with a synchronization step and by stating 'importance' by itself could not be a motivation. *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995) (stating that even when changes from the prior art are "minor" or "simple," an inquiry must be made as to whether "the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes" (quoting *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 935, 15 USPQ2d 1321, 1324 (Fed. Cir. 1990))). The examiner has therefore failed to inquire whether there is a need for downloadable step linked to a verification step in Morrill such that a motivation could be found to combine with Moussaeu. If the nature of the problem is not found in Morrill then how could one skilled in the art be motivated even if Moussaeu taught the said importance ? And the fact that it is 'important' is only conclusory given that Morrill has no teaching or need in the first place. Further, despite the suggestion of importance, neither of these references includes any suggestion to combine its features with the features of the other reference.

As for Resnick which is aligned to payment system utilizing intermediary stored value account as a way to receive payments for prepaid services, ie backwards in that payments

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are received rather than as credit card in extending the credit. The said system includes anonymity features etc. ( Resnick Col 1-2).

As mentioned none of these invention teach existing utilities accounts ( by creating subsidiary accounts) for the purpose of transacting payments. Even if Resnick's uses an intermediary account such an account does not fairly show one created from the user's utility main account. In fact Fig 1 of Resnick clearly shows the intermediary account is outside of the wireless carrier platform. In short, Resnick uses an intermediary such as a merchant's POS to receive the money and later credit this money under segregated accounts operated by the user to pay vendors of their choice. However, a merchant's account even though an aggregated one is NOT obvious to our invention of using the utilities sub-accounts.

Our detail rebuttals are submitted as follows. Our amendment is in accordance to Appendix 1 (marked version) which we respectfully ask the examiner to incorporate the changes. Appendix 2 shows the CLEAN version as required in accordance to Action Letter mailed 10 Jan 2005.

Analysis of Examiner's assertion.

Claims 1-16

We respectfully traversed the examiner's rejection.

The examiner has grouped Claim 1-16. We object to this grouped rejection as it does not afford conclusive evidence to consider each of the elements in the dependent claims which may not be obvious without a motivation for a 103(a) rejection. In short, the

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examiner has failed to articulate a motivation to reveal each of the missing elements such as utilities account in Claim 1 including extending the utility accounts for sub-accounts, as per claim 2 ; utility units wherein the 'exchangeable' novelty is for payer to pay from gas account to electricity account of payee etc. "unless the prior art suggested the desirability of [such a] modification" or replacement. In re Gordon, 733 F.2d 900, 902 , 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).

**Payment initialization through a telecommunication network and not Internet.**

The examiner stated that Morrill teach a method using utility accounts including a wireless device at Col 1 lines 18-24. And as mentioned Morrill deals exclusively with telco accounts over a telco network and not utilities accounts as defined in our application. At Col 4 lines 16-38, Morrill described the cell phone being an electronic wallet and funds are transferred between mobile phone accounts of the parties or arrange with financial account or credit card or brokerage.

**Failure to show inherency of mobile phone accounts to reveal our non mobile phone utilities account.**

However, there is no mentioned of utilities accounts such as gas, water, electricity or data communication accounts in Morrill. Data accounts in general would be Internet accounts (with ISP ) and not mobile phone accounts. In particular the Morrill's invention involves a method of using a mobile phone together with a mobile phone account and/or financially linked accounts for payment over a telco network. This is evidenced from Col

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3 lines 25 to line 35. There is great emphasis on mobile phone account as can be seen in Col 4 line 41 to line 47 "The vendor must have either a mobile phone account or an arrangement with the mobile phone service..... The purchaser must have a mobile phone service agreement and in this case, have with him/her their cellular phone." Also see Col 11, line 44 to line 47 referring to mobile accounts and other financial accounts. However, nothing in all the prior arts show any reference to utilities accounts nor any teaching fairly show how these utilities accounts could be used for payment. Neither is there any evidence to show a mobile phone account must necessarily reveal utility accounts to one skilled in the art.

Missing central payment processor connected to the Internet.

Structurally, Morrill also failed to show having a central payment processor linked to the Internet. Morrill shows CPU in mobile service provider debiting and crediting accounts within its own network as its devices are linked directly. This inherently means Morrill did not teach intra-funding payment (ie between two different telcos). More importantly requires two parties to interact with each other for the fund transfer. ( Col 3 line 6-25)...In particular, is mentioned "The CPU debits and credits the appropriate accounts and creates an electronic record of the transfer." Our claimed invention has no requirement for two parties to interact for a user to user transfer. The user need only provide his account and the payee's account.

Confirmation and verification using a mobile device.

Our claimed invention while applying a mobile phone, this device is for confirmation and verification purposes rather than for initiating a transaction. In short, our claimed invention could even work without such a device as the whole transaction could be

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completed on line although perhaps with lesser security. See our specification at page 8/9 where we reproduced the relevant para below :

“Preferably, the method includes the step of initiating a purchase over the Internet by entering the account number with a specific utility provider as the identifying account to be debited. This step is similar to using credit card but instead of the credit card number, a sub account number is used instead. This is followed by an authorisation query where the user/purchaser need to response by entering his or her password that is provided on opening the utility purchasing sub account. This password can be keyed in from the buyer’s terminal.”

As we mentioned in page 6 of our specification (another preferred method), the mobile device in our claimed invention is to ensure identity could be confirmed (via a second network) when an Internet payment is made through the net (via a first network) in Fig A. This splitting of networks to check and confirm provides a second layer of security but as we mentioned, our mobile device could not be for initiating/making a payment as in Morrill (see Fig B) . The question is whether Morrill’s invention could work without the mobile device because the difference here is that our claimed invention would still work without the said mobile device as it does not use any mobile accounts nor initiate a payment on the mobile device.

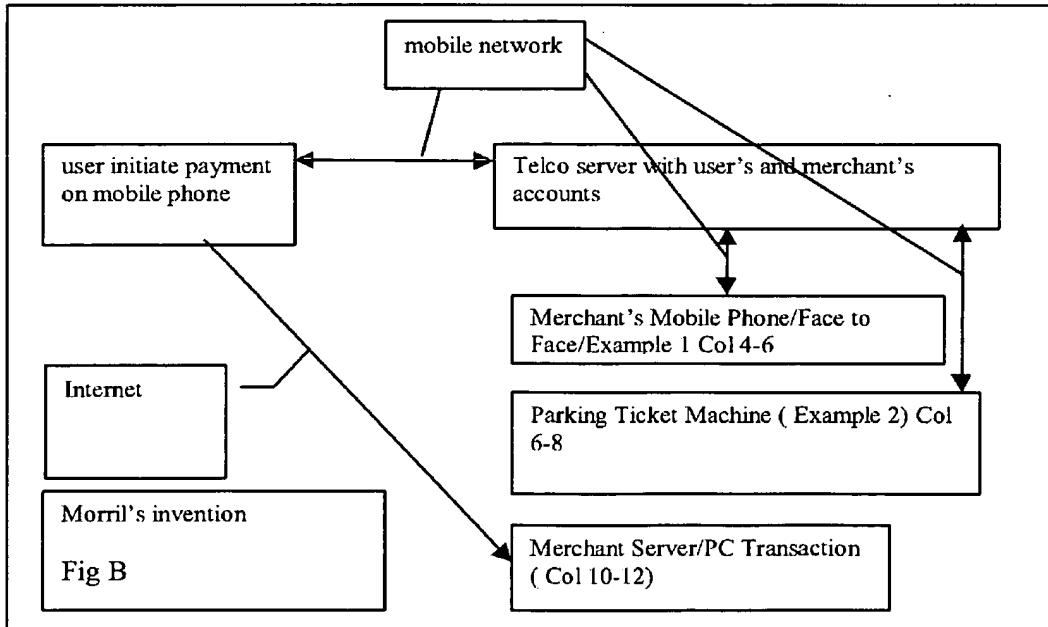
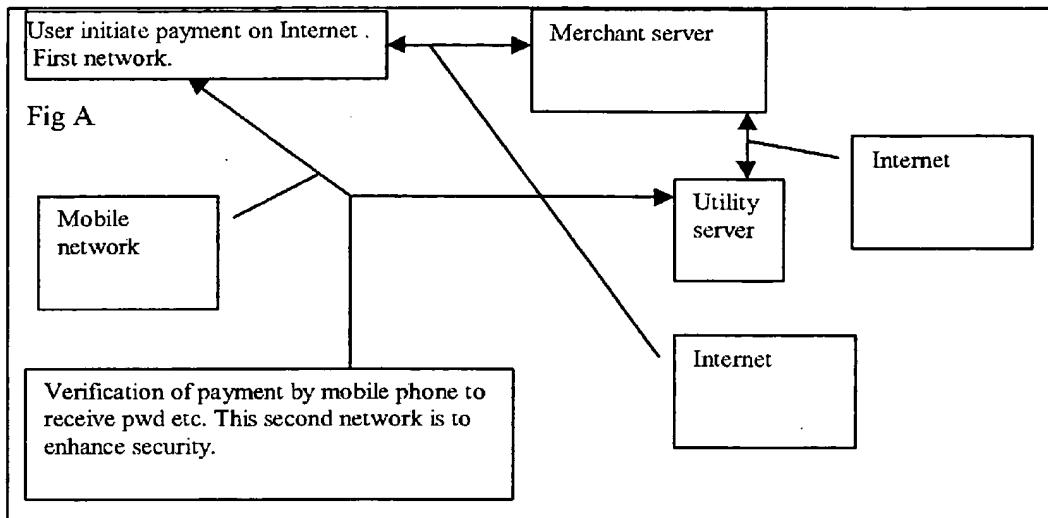
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No special function code at the outset to start the transaction ?

Morrill has placed reliance on the use of "function" code recognizing the limitation of mobile telco system where codes representing commands such as \*\*\*#123P may have a special meaning as to merely numbers, as the latter will dial a call instead of diverting to make a payment. Our claimed invention has no such requirements as the transaction is completed over a computer with another computer (not mobile phone to a telco computer as Fig B above) over the Internet and where applicable we use the mobile phone only as a secondary source for verification ( Fig A). For example a transaction could be initiated over the Internet link to utility computer (first route) but as a safety precaution, the utility computer will response back to a mobile phone for confirmation (second route).

Obviously only the linked user's mobile phone number stored in the utility system will be called. In contrast, Morrill only teach of using the mobile phone to satisfy the evidentiary transaction by forwarding the confirmation code to transmit this to the vendor's computer over the Internet (Col 11 line 28-Col 12 line 27) and NOT using the mobile phone device to initiate a payment transaction over the Internet. ( See Fig B above at PC Transaction ) As mentioned there is no motivation to modify Morrill's device to detour into the Internet to reach its service mobile provider when its already directly linked to it by wireless means.

Even if these utilities accounts could some how have corresponding elements to a mobile phone accounts ( which we submit is not ), Morrill still fail to fairly disclose how to practice with said accounts. ("a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests," In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979)). In this case, there is no evidence it shows how

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utilities billing could be used for payments between users nor the novelty of using utility units as for payment.

"Obvious to try" a modification or combination (looking for a needle in a haystack) is not *prima facie* obvious.

Another problem here is that there are also an infinite type of accounts such as cash account, asset account, bank account, clothing account, grocery account, inventory account, check account, fuel account, orange juice account, pork belly account (generally found in commodities market), expense account, depreciation account, entertainment account, tea money account etc. In short anything of value can be grouped under an account for the purpose of accounting for the usage but could any of them also used for making payment ? Therefore, given the nearly infinite number of possibilities that could be suggested with hindsight, and the failure of the cited prior art to suggest any of them including our utilities account as claimed, we submit the claimed accounts would not have been obvious. See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed.Cir.1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."). Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed.Cir.1991).

#### Novelty of Utility Units

We further describe electronic methods to transfer funds or utility units from one type of utility account to another, say gas to electricity. Morrill taught mobile phone accounts